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| 10/785,618 | 02/23/2004 | Christopher M. Look | 8433P009 | 2967 |
| 8791 7590 11/03/2009 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040 | | | EXAMINER LEUNG, WAI LUN | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/785,618 | Applicant(s) LOOK, CHRISTOPHER M. | |
| | Examiner DANNY W. LEUNG | Art Unit 2613 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20090717</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Furthermore, the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.* note that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn* 441 F.3d977,988,78 USPQ2d1329,1336(Fed.Cir.2006) stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

2. Claims 1, 2, 5, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaguchi** (US006847743B2).

Regarding claims 1 and 9, **Yamaguchi** discloses A method comprising:

splitting an incoming optical signal into a first and a second optical signals (*fig 1, receiving signal from transmission line fiber 4, splitter 10-3 split signal into two*);

sending the first and the second optical signals to a first and a second equipments in an optical network node, (*fig 1, polarization scrambler 2-1 is the first equipment and the polarization scrambler 2-2 is the second equipment*), respectively, the second equipment being a protection module for the first equipment (*col 5, ln 20-25, the polarization scrambler 2-1 is a "current system" and the other line is "auxiliary system"*);

monitoring a first and a second outgoing optical signals from the first and second equipments (*fig 1, detecting circuit 12-1 and 12-2 monitors the output of the polarization scrambler 2-1 and 2-2*);

using a switch to select outputting only one of the first and the second outgoing optical signals from the optical network node via a switch (*fig 1, switch 14-1, 14-2, and switch driving circuit 15 is functionally equivalent to a switch since they only select one of the first and second optical signal to be outputted by one of the polarization scramblers*);

outputting the only one of the first and the second outgoing optical signals selected (*col 5, ln 18-31, the switches and the scrambler driving circuits are set to ON and OFF so that only one is outputted*);

declaring a failure of the optical network node if only one of the first and the second outgoing optical signals has failed (*col 5, ln 33-43, controlling circuit 13 declare a failure of the optical network node by outputting a control signal to the switch driving circuit to attempt to recover this failure*).

Yamaguchi teaches a method of optical signal recovery by using a switch to select an auxiliary system (*second equipment*) output when it detects a fault in the current system (*first equipment*), *as discussed above*, for the purpose of generating a working output signal using the auxiliary system (*second equipment*).

Yamaguchi does not expressly teach how the system reacts when both of the signals have failed. However, it would have been obvious for a person of ordinary skill in the art at the time when the invention was made to recognize that if both outgoing optical signals from the current system (*first equipment*) and from the auxiliary system (*second equipment*) are failed, a working signal output is impossible to accomplish even if it were to switched to the auxiliary system (*second equipment*), *therefore*, it makes no difference to the system output by changing or maintaining the state of the switch, and there would be no point of switching to the auxiliary system or to the current system.

It follows, that there is no point for the controlling circuit to declare to the switch that the optical network node has failed, because there is nothing the switch can do to generate a working signal, and it would have been obvious for a person of ordinary skill in the art at the time when the invention was made to not generate this declaration so as to save on processing memory and to enhance processing speed of the overall system by eliminating unnecessary declarations.

Therefore, it would have been obvious for a person of ordinary skill in the art at the time when the invention was made to maintain a signal selection state of the switch in **Yamaguchi's** system, such that it continue outputting only one of the first and the second

Art Unit: 2613

outgoing optical signals in the same direction without declaring that the optical network node has failed if both of the first and the second outgoing optical signals have failed, and yields predictable results. Since there is a finite number of identified predictable potential possibility of operating the switches (*maintaining the state or changing the state*) to solve the problem, as a part of undue experimentation, one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success. Therefore, the rationale to support a conclusion that the claim would have been obvious has been clearly articulated in that “a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under 103.” In *KSR*, 550 U.S. 82 USPQ 2d at 1397. **MPEP 2143** Section E.

As to claims 2 and 10, **Yamaguchi** further teaches bypassing the first optical equipment if the first optical signal has failed and the second optical signal has not failed (*col 5, ln 32-43*), ; and

bypassing the second optical equipment if the second optical signal has failed and the first optical signal has not failed (*col 9, ln 12-20, the switching unit is capable of switching between the polarization scramblers*).

As to claim 5, **Yamaguchi** further teaches amplifying the first and the second optical signals at the first and second equipments, respectively (*fig 7, amplifier 17-1 and 17-2*).

3. Claims 3, 4, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaguchi** (*US006847743B2*), in view of **Palacharla et al.** (*US 20040141741A1*).

Regarding claims 3 and 11, **Yamaguchi** discloses the method of claims 2 and 9 as discussed above. **Yamaguchi** does not disclose expressly sending an alarm if either the first or the second optical signal has failed. **Palacharla**, from the same field of endeavor, teaches sending an alarm if either a first or a second optical signal has failed (*paragraphs 41, if it detects a failed signal was sent or received from the optical equipment, it generates a transponder failure alarm*). Therefore, it would have been obvious for a person of ordinary skill in the art at the time of invention to generate an alarm if the first or second optical signal in **Yamaguchi**'s system has failed as suggested by **Palacharla**. The motivation for doing so would have been to easily identify location of the fault.

As to claims 4 and 12, **Palacharla** further teaches declaring a failure has occurred outside of the optical network node if both the first and second optical signal have failed (*paragraphs 42 a network failure is detected, failure detection is based on failure signals received from or transmitted to client 204, fig 2 shows the client A 204a is receiving signal from both the working and the protection modules 208*).

4. Claims 6-8, and 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaguchi** (*US006847743B2*), as applied to claim 1 above, and further in view of **Kuroyanagi et al.** (*US006433900B1*).

Regarding claims 13 and 19, **Yamaguchi** discloses the protection switching method with a first and second equipments in an optical network node in accordance to

claim 1 as discussed above. **Yamaguchi** does not disclose expressly wherein the method is applied to an apparatus comprising a first optical equipment in an optical network device having a first plurality of input ports and a first plurality of output ports; a plurality of splitters, and a plurality of optical signal switches. However such optical system is common and well known, for example, **Kuroyanagi**, from the same field of endeavor, teaches an apparatus (*fig 8A*), comprising: a first optical equipment in an optical network device having a first plurality of input ports and a first plurality of output ports (*fig 8A, XC Node o-system has a plurality of input and output ports*);

a second optical equipment in the optical network device having a second plurality of input ports and a second plurality of output ports, the second optical equipment being a protection module of the first optical equipment (*fig 8A, XC Node I-system has a plurality of input and output ports*);

a plurality of optical signal splitters, each of the plurality of optical signal splitters coupled to one of the first plurality of input ports and one of the second plurality of input ports, to split an incoming optical signal into a first and a second optical signals and to input to the first and the second optical equipments, respectively (*fig 8A, optical distributor 60 split the incoming signals $\lambda_1 - \lambda_n$ to the o-system and I-system, respectively*), ; and

a plurality of optical signal switches (*fig 8A, protection switch 61*), each of the plurality of the optical signal switches coupled to one of the first plurality of output ports and one of the second plurality of output ports.

Therefore, it would have been obvious for a person of ordinary skill in the art at the time of invention to apply the general protection switching methods as discussed above regarding claim 1 as a known technique to improve a known system with a plurality of input ports, a plurality of output ports, a plurality of splitters, and a plurality of switches such as that of **Kuroyanagi's**, and the results would have been predictable. In *Dann v. Johnston* 525 U.S. 219, 189 USPQ257 (1976) The Court held that “[t]he gap between the prior art and respondent’s system is simply not so great as to render the system nonobvious to one reasonable skilled in the art.” **MPEP 2143** Section D.

Regarding claims 6, 16, and 22, **Yamaguchi** discloses the protection switching method in accordance to claim 1 as discussed above. **Yamaguchi** does not disclose expressly wherein each of the first and second equipments comprises a wavelength switch module. **Kuroyanagi**, from the same field of endeavor, teaches a protection switching method having a first and second equipments comprises a wavelength switch module (*fig 8A, optical XC node in 1-system and 0-system*). Therefore, it would have been obvious for a person of ordinary skill in the art at the time of invention to apply the general protection switching method as discussed above regarding claim 1 as a known technique to improve a known system where a first and second equipments comprises a wavelength switch module suggested by **Kuroyanagi**, and the result of which would have been predictable

As to claims 7, 17, and 23 , **Kuroyanagi** further teaches wherein each of the first and second equipments further comprises a multiplexer and a de-multiplexer (*fig 8A*).

As to claims 8, 18, and 24, it is common and well known to use amplifiers anywhere in an optical system, so as to improve signal quality along the optical signal transmission line, therefore, it would have been obvious for a person of ordinary skill in the art at the time when the invention was made to use an amplifier for amplifying the first and the second optical signals at the first and second equipments, respectively, and the result of which would have been predictable.

As to claims 14 and 20, **Yamaguchi** further teaches wherein the optical signal switch selects the second output optical signal from the second optical equipment if the first output optical signal from the first optical equipment fails and the second output optical signal from the second optical equipment has not failed (*col 5, ln 32-43*).

As to claim 15 and 21, it would have been obvious to have the optical signal switch selects the first output optical signal from the first optical equipment if the second output optical signal from the second optical equipment fails and the first output optical signal from the first optical equipment has not failed (*it is obvious to switch to a working equipment from a failed equipment*).

Response to Arguments

5. Applicant's arguments with respect to claims 1-24 have been considered but are not persuasive.

Applicant argues that **Yamaguchi** has been silent on what happens if both the current system and the auxiliary system fail, which is noted by the last Office Action, and

because Yamaguchi fails to teach all limitations set forth by claim 1, claim 1 is patentable over Yamaguchi. Examiner respectfully disagrees.

While the last Office Action stated that **Yamaguchi** does not expressly describes what happens if both the current system and the auxiliary system fail, the last Office Action also stated that it would have been obvious for a person of ordinary skill in the art at the time when the invention was made to recognize it is practical sense that if both the current system (*first equipment*) and the auxiliary system (*second equipment*) are failed, a working signal output is impossible to accomplish even if it were to switched to the auxiliary system (*second equipment*), and therefore it makes no difference to the system output by changing or maintaining the state of the switch, and therefore there would be no point of switching to the auxiliary system or to the current system. Further, it simply makes practical sense to a person of ordinary skill that there is no point for the controlling circuit to declare to the switch that the optical network node has failed, because there is nothing the switch can do to generate a working signal, and it would have been obvious for a person of ordinary skill in the art at the time when the invention was made to not generate this declaration so as to save on processing memory and to enhance processing speed of the overall system by eliminating unnecessary declarations.

In *KSR*, 550 U.S. at ___, 82 USPQ2d at 1397. “a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill

and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.”

Furthermore, In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,”*Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”*Id.* at ___, 82 USPQ2d at 1395.

That is, simply because **Yamaguchi** fails to teach all limitations set forth all limitations of claim 1 as amended, does not make it patentable. **The rationale** for proving the limitation “maintaining a signal selection state of the switch to continue outputting the only one of the first and the second outgoing optical signals in the same direction without declaring that the optical network node has failed if both of the first and the second outgoing optical signals have failed” unpatentable is that it is **obvious to try** for a person of ordinary skill, **because it simply makes practical sense** to not switch to an auxiliary system if the auxiliary system would not help to recover the working signal, and it makes no sense to declare failure to the switch if the system is not switching to the auxiliary system. Such implementation is one of a finite number of identified, predictable potential solutions to the problem, and one of ordinary skill could have

pursued the known potential solutions with a reasonable expectation of success, which is not of innovation but of ordinary skill and common sense. *See* **MPEP 2143** Section E.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to optical communications with protection switching in general:

(US-20020044315 or US-20050135810 or US-20050180316 or US-20040208578 or US-20040208506 or US-20040141741 or US-20040114925 or US-20040105136 or US-20020021659 or US-20030180047) or (US-6980711 or US-6950215 or US-6934469 or US-6433900 or US-7099578 or US-6947623 or US-6983108 or US-6771908 or US-6819875 or US-7197241 or US-5594581 or US-5130837 or US-6307653 or US-6850515 or US-6754449 or US-7161898 or US-6898376 or US-6556319 or US-6477288 or US-7242860 or US-5539564 or US-6868232 or US-5559622 or US-7174096 or US-7283748 or US-7283740) or (US-6847743)

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANNY W. LEUNG whose telephone number is (571)272-5504. The examiner can normally be reached on 10:00am-8:00pm Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DANNY W LEUNG
Examiner
Art Unit 2613

/D. W. L./
Examiner, Art Unit 2613
11/3/2009

/Kenneth N Vanderpuye/
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